

Attorney Docket: 4925-18CPA

Serial No.: 09/476,674
Amtd. dated June 7, 2004
Reply to Final Rejection dated April 5, 2004

REMARKS

The Final Office Action mailed April 4, 2004 has been reviewed and carefully considered. Before entry of the present amendment, Claims 1-8 and 10-24 were pending, with Claims 1, 6, 10, and 24 being in independent form. In the present amendment, Claims 1-8 and 10-23 have been cancelled without prejudice. After entry of the present amendment, only independent Claim 24 will be pending. Reconsideration and withdrawal of the rejections in the April 4, 2004 Office Action are requested on the basis of the following remarks.

The rejections of Claims 1-8 and 10-23 have been rendered moot by their cancellation in the present Amendment. It should be clearly understood, however, that their cancellation is made in order to put the application in better form for appeal, i.e., so that the appeal may focus on the single issue of the insufficiency of the §103 rejection of independent Claim 24. Applicant retains the right to re-introduce any of those claims, and/or any material recited in any of those claims, at a later point in the prosecution of this patent application or another patent application claiming priority from this patent application.

In the Office Action dated April 5, 2004, the Examiner rejected independent Claim 24 under 35 U.S.C. §103(a) as unpatentable over LAMBERT (Lambert, P., "FCC puts satellite DAB plan up for comment," *Broadcasting*, Vol. 122, no. 143 (October 19, 1992), p. 28, hereinafter LAMBERT) in view of *Foladare et al.* (U.S. Patent 5,819,160, hereinafter *Foladere*), *Eller et al.* (U.S. Patent 5,889,860, hereinafter *Eller*), ROTHBLATT (Rothblatt, M., "Talking stars and talking cars," *Satellite Communications*, Vol. 14, no. 6 (June 1990), p. 12, hereinafter ROTHBLATT), *Rakavy* (U.S. Patent 5,913,040, hereinafter *Rakavy*), and AT&T ("AT&T Launches Digital PCS Personal News; Customized News, Weather, Sports, and More Sent Directly to AT&T Wireless Customers' Digital PCS Phones," *Business Wire*, (August 3, 1999), p. 13, hereinafter AT&T) (Office Action, page 34).

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three criteria must be met: 1) there must be some suggestion or motivation, either in the form of the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable

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expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. See MPEP §706.02; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The §103 rejection of independent Claim 24 in the April 5, 2004 Final Rejection does not establish a *prima facie* case of obviousness because (1) there is no motivation or suggestion to combine all six references; and (2) even when impermissibly combined, the combination neither teaches nor suggests all of the limitations recited in independent Claim 24.

Independent Claim 24 recites a method for providing "an electronic "book-of-the-month" subscription service" for a cellular telephone user. In the method, the cellular telephone user first subscribes to the service "by interacting with a subscription server on the Internet." After the user has subscribed, thereby becoming a 'subscriber', the cellular telephone of the subscriber receives offers to download digitally formatted electronic texts "at predetermined time intervals and without user action", where each offer is accompanied by a portion of the digitally formatted electronic text being offered, where the user can access a preview portion of the at least a portion of the digitally formatted electronic text using the cellular telephone, and where the offer to download the digitally formatted electronic text is sent to the user if the digitally formatted electronic text corresponds to user-specific information provided by the user and stored at the subscription server.

After receiving an offer, the subscriber transmits via the cellular telephone a response indicating whether the subscriber wants to download the digitally formatted electronic text into the subscriber's cellular telephone. What happens next depends on what was originally downloaded into the cellular telephone with the offer: either only a portion of the electronic text was downloaded or the entire electronic text was downloaded but only a preview portion of the electronic text was available for viewing by the subscriber. If the subscriber has indicated that the subscriber wants to download the digitally formatted electronic text into the cellular telephone, and only a portion of the digitally formatted electronic text has been downloaded into the cellular telephone, the remaining portion of the electronic text is transmitted into the cellular telephone. If the subscriber has indicated that the subscriber wants to download the digitally formatted electronic text into the cellular telephone, and the entire digitally formatted electronic text has already been downloaded into the cellular telephone, a "decoding message" is transmitted to the cellular telephone. The decoding message is used to unlock a "gateway lock

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which prevents the user from accessing more than the preview portion of the entire digitally formatted electronic text".

Because of the extensive length and large number of limitations in Claim 24, we are only going to discuss the first step of the method claimed therein as representative of the plurality of errors that have been made in this rejection. The first step is reproduced below:

"subscribing, by the user, to the on-line subscription service by interacting with a subscription server on the Internet, wherein said step of subscribing comprises the sub-step of:

transmitting user-specific information provided by the user to the subscription server which stores the user-specific information, wherein the user-specific information comprises at least one of the capabilities of said mobile terminal, the preferences of the user, and other information related to the user; "

The portion of the Examiner's rejection of Claim 24 in the April 5, 2004 Final Rejection directed to the above step is reproduced below:

Regarding claim 24, Lambert, teaches a method of providing an electronic "book of the month" subscription service to a user of a cellular telephone network on a cellular telephone network, comprising the steps of:

subscribing, by the user, to the subscription service; and transmitting to the mobile terminal, a digitally formatted product.

Lambert does not expressly teach subscribing, by the user, to the on-line subscription service *by interacting with a subscription server on the Internet*. However, Foladare teaches permitting a user to subscribe to a service for providing music over a wireless network wherein the user enters his account information over the Internet (Fig. 2; col. 2, lines 31-35; col. 5, lines 39-51). At the time of the applicants invention, it would have been obvious to one of ordinary skill in the art, to modify Lambert to include subscribing, by the user, to the on-line subscription service *by interacting with a subscription server on the Internet* in order to provide users with a convenient means for subscribing to a music service.

Lambert does not expressly teach *wherein said step of subscribing comprises the sub-steps of transmitting user-specific information provided by the user to the subscription server which stores the user-specific information, wherein the user-specific information comprises at least one of the capabilities of said mobile terminal, the preferences of the user, and other information related to the user*. However, Foladare teaches a method of subscribing to a music service wherein a user interacts with an Internet server to provide user-specific information, including a subscriber identification code (col. 2, lines 26-37; and col. 5, lines 39-54). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify Lambert to include Foladare's teaching of *wherein said step of subscribing comprises the sub-steps of transmitting user-specific information provided by the user to the subscription server which stores the user-specific information, wherein the user-specific information comprises at least one of the capabilities of said mobile terminal, the preferences of the*

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user, and other information related to the user. This combination would provided the music subscription service with user identification information thereby enabling the subscription service to maintain the account activity of a plurality of users.

This rejection, on first glance, may not appear unreasonable (except, perhaps, for the "motivation" for combining LAMBERT and *Foladare*). However, once one has read the LAMBERT and *Foladare* references, the reasoning in the passages reproduced above is very difficult to understand.

LAMBERT is a 711 word article from 1992 in which three different news items concerning three different technologies (satellite-delivered digital audio broadcasting (DAB), next generation AM/FM radio receivers that are capable of receiving and displaying text, and encryption devices for cable and satellite descramblers) are discussed. It is assumed, but completely unknown (for the Examiner does not bother to provide citations to any specific portion of LAMBERT), that the Examiner intends for the first story in LAMBERT to teach the step of "subscribing, by the user, to the on-line subscription service". In the first section (LAMBERT, page 1, ¶¶1-7), it is reported that the FCC accepted an application from a company called Satellite CD Radio to deliver CD-quality audio services to satellite receivers mounted in automobiles. This section mentions that Satellite CD Radio plans to launch two satellites ("birds") which will "deliver 30 channels of nonstop commercial-free subscription and "pay-per-listen" music formats" (LAMBERT, page 1, ¶5) and "[f]or a subscription fee of about \$5-10 per month, ...it will deliver ... formats ... rarely available in local radio markets" (LAMBERT, page 1, ¶¶6). This section does not describe how a user subscribes to these satellite radio services, nor does it define the term "pay-per-listen".

Foladere describes a radio subscription service in which a user using a digital radio remotely accesses a subscription control system where the user selects content from a content database and the selected content is stored as a "playlist" (*Foladare*, Abstract; col. 2, lines 1-7). A playlist may consist of user-selected musical pieces or audio literary works (*Foladare*, col. 2, lines

* The second story in LAMBERT (page 1, ¶¶8-10) is a report that the National Radio System Committee (NRSC) approved a new standard called "Radio Broadcast Data System (RBDS)" for AM/FM radio broadcasts. This new standard would allow the next generation of AM/FM radio receivers to receive text transmissions, such as station identifications, program information, and emergency alerts (LAMBERT, page 1, ¶9). The third story in LAMBERT (page 2, ¶¶1-4) is a report that the FCC is expected to undertake an official inquiry into encryption technology for cable programming. The impetus for the inquiry appears to be the fact that General Instrument "remains the only supplier of decoders" (LAMBERT, page 2, ¶2). It is assumed these two stories are not being cited as teaching or suggesting the step of "subscribing ... to [an] on-line subscription service".

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45-55). In addition, the user may select a predefined keyword, such as "BASEBALL", or a predefined playlist, such as this week's top ten musical works in a particular genre (*Foladare*, col. 2, lines 55-62; col. 6, lines 4-13). In these cases, the subscription system automatically selects the items to be put in the playlist (*id.*). Later on, the user can re-connect to the subscription control system and request a playlist, whereupon the items in the playlist are transmitted to the user's digital radio for playback (*Foladare*, Abstract; col. 2, lines 1-7). Although the service in *Foladare* is called a "subscription" service, no description or suggestion of how the user initially subscribes to the service is provided; in addition, the user in *Foladare* always initiates contact with the subscription service, i.e., the subscription service never contacts the user.

This point bears repeating: **neither LAMBERT nor *Foladare* teach, suggest, or otherwise discuss *how* users subscribe to their services.** In other words, the two references which, according to the Examiner, render obvious the step of "subscribing" in Claim 24 never discuss or explain a step or procedure of "subscribing". Of course, it is true that users must somehow subscribe to the services described in LAMBERT and *Foladare*. Thus, it is implicit that a step of "subscribing" must occur at some point, in some way, in *Foladare* and LAMBERT. It is difficult to see how that thin reed (that a subscribing step must occur) can support an obviousness rejection of the step of "subscribing, by the [cellular telephone] user, to the on-line subscription service by interacting with a subscription server on the Internet" which further comprises "transmitting user-specific information provided by the user to the subscription server which stores the user-specific information, wherein the user-specific information comprises at least one of the capabilities of said mobile terminal, the preferences of the user, and other information related to the user".

Since the Examiner provides no citations to any particular text in LAMBERT, we can only examine *Foladare* to discover how or why the Examiner believes *Foladare* teaches, suggests, or otherwise discusses how a user subscribes to the music subscription service described therein. The Examiner cites FIG. 2; col. 2, lines 31-34; and col. 5, lines 39-51 of *Foladare*. FIG. 2 is a flowchart of how a subscriber (i.e., one who has already performed the process of subscribing) configures new playlists or edits existing playlists. Lines 31-34 of col. 2 explain that the creation of new playlists or the editing of old playlists, such as is shown in FIG. 2, can be performed over a remote connection "preferably accomplished via a data network, such as the Internet, in which the subscriber uses a computer equipped with a modem to interact with the subscription control system".

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Similarly to the two other citations of the Examiner, the lengthy passage ("col. 5, lines 39-51") cited by the Examiner *does not describe how users subscribe to the service*; in fact, there is only one passing reference to the fact that users have to initially subscribe to the service ("The subscriber ID code is a code unique to each subscriber and is assigned by the system when a subscriber subscribes to the system ...," emphasis added, *Foladare*, col. 5, lines 47-49). Although "a radio subscription system" and "a subscription content database" are referred to in *Foladare*, neither of these objects are used to initially subscribe the user. The "radio subscription system" is where both audio content and each user's playlists are stored (*Foladare*, col. 3, line 59-col. 4, line 46). The "subscription content database" stores audio material and information concerning the stored audio material (*Foladare*, col. 4, lines 21-38). There is no suggestion in *Foladare* that either the subscription system or the subscription content database is used to sign up a subscriber. *Foladare*, either alone or in combination with LAMBERT, does not teach, suggest, or otherwise discuss a user interacting with a subscription server on the Internet in order to subscribe to an on-line subscription service (as recited in the first step of Claim 24 of the present application).

Putting aside the fact that LAMBERT and *Foladare* do not teach or suggest the first step of Claim 24, it is not clear what would motivate one skilled in the art to combine LAMBERT and *Foladare*, neither of which describe how users subscribe to their services, in order to teach a step of subscribing, by a cellular telephone user, to a subscription service in which offers to download digitally formatted electronic texts are transmitted to the user's cellular telephone, where said subscribing step is performed by interacting with a server on the Internet.

This problem of vague and difficult-to-understand motivations for combining the prior art references is epidemic in the April 5, 2004 Final Rejection. As an example, consider the excerpt from the April 5, 2004 Final Rejection below:

Assuming, *arguendo*, Lambert, Foladare, Eller and Rothblatt do not teach providing an offer *at predetermined time intervals and without user action*, Rakavy overcomes this ostensible deficiency. Rakavy discloses a method and system for transmitting advertisements over a network wherein advertisements are selected based on user-defined preferences, and transmitted to users when a low level of network traffic is detected. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Lambert, Foladare, Eller and Rothblatt to include the teachings of Rakavy. Providing users with an offer *at predetermined time intervals and without user*

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action would provide a means of increasing advertising effectiveness since users will not be desensitized by a constant stream of advertising. Moreover, emphasizing Rakavy's intermittent offer feature would enable the subscription system to make its offers to download music in between songs.

It is not clear from the above excerpt how or why the combination of LAMBERT, *Foladare*, *Eller*, ROTHBLATT, and *Rakavy* teaches the step of "transmitting to the cellular telephone via the cellular telephone network at predetermined time intervals and without user action offers to download a digitally formatted electronic text". *Rakavy* teaches sending advertisements to selected computers over the Internet. How or why does that teach the limitation of "at predetermined time intervals and without user action" within the context of the particular step in Claim 24? It is difficult to respond to such reasoning. Moreover, this reasoning is indicative of the Examiner's lack of analysis of the invention claimed in Claim 24 *as a whole*. In this connection, it is helpful to consider the Federal Circuit's guidance for §103 obviousness rejections in *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000):

Section 103 of title 35 of the United States Code states:

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. § 103 (a) (2000).

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted

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by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

In short, the Examiner completely fails, in his rejection of Claim 24, to consider the invention claimed therein as a whole at any point in the April 5, 2004 Final Rejection. In fact, the very manner in which the Examiner has responded to applicant's traversals points to the lack of any consideration of the claimed invention as a whole. In essence, every time the applicant has pointed out a claim limitation not taught by the Examiner's cited combination of prior art references, the Examiner has merely found another prior art reference which the Examiner believes teaches that specific claim limitation. Thus, the list of cited prior art references becomes longer in each subsequent Office Action, but the motivation for combining them becomes more and more tenuous. In each of the previous Amendments, applicant has pointed out that the Examiner has not provided a clear motivation for combining the cited references. At long last, in the April 5, 2004 Final Rejection, the Examiner responded to applicant's explicit traversal, in regards to the lack of a motivation to combine, of the Examiner's §103 rejections:

Applicant argues that the Office Action lacks specificity in indicating how the combination of prior art references teaches Applicant's invention. As an example of this lack of specificity, Applicant points to the purported lack of clarity in the Examiner's reasoning for combining the cited references to reject the claims under §103. However, the Examiner notes Applicant has argued that the Examiner's motivation for combining the references amounts to hindsight reasoning. Since the Examiner's motivation was expressed clearly enough for Applicant to argue that the Examiner has applied hindsight reasoning, the explanation for the motivation to combine references is sufficiently clear to communicate the Examiner's reasoning. Accordingly, the Examiner submits sufficient clarity has been applied in rejecting the claims.

§707.07(f) of the MPEP states that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it". It is respectfully submitted that this is not an "answer" to "the substance of" the traversal.

Of course, as is noted by the Examiner, the steadily increasing number of references used by the Examiner in his §103 rejections is not proof, in and of itself, of hindsight reconstruction. However, it is indicative of a piece by piece, element by element, reconstruction of the claimed

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invention, especially when considered in combination with the lack of any motivation within the references themselves to combine the references. The mere fact that the Examiner might be able to find each element of the claimed invention by combining a list of prior art references does not prove obviousness under §103. It is not correct for the Examiner merely to focus on the differences between the prior art and the claimed invention, and then to state that the differences themselves or individually are obvious. The claimed invention as a whole is to be considered (see, e.g., *Lear Siegler, Inc. v. Aeroquip Corp.*, 221 USPQ 1025, 1033 (Fed. Cir. 1984): "... the actual determination of [obviousness] requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as a whole, not merely the differences between the claimed invention and the prior art", emphasis added).

As was mentioned above, another problem with the §103 obviousness rejections is the complete lack of specificity in terms of indicating how the combination of prior art references teaches the limitations of the present claims. As stated by the Federal Circuit, "[t]he need for specificity" is essential when explaining how a prior art combination teaches all the components in a claim rejected under §103 (*In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002)). Furthermore, the Examiner must "not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the [PTO]'s conclusion" (*Id.*, at 1344) and those findings "must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." (*Id.*, at 1344-1345). In the instant case, similarly to the *In re Lee* case, the Examiner is not providing adequate specificity in his rejections. As stated by the Federal Circuit, "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (emphasis added, *In re Kotzab*, 217 F.3d 1365, 1371, (Fed. Cir. 2000). Furthermore, the Examiner "must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." (emphasis added, *In re Rouffet*, 149 F.3d 1350, 1359, (Fed. Cir. 1998)). Insofar as the Examiner's reasoning for combining the cited prior art references is unclear, the Examiner has not made a *prima facie* case of obviousness.

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Independent Claim 24 of the present application recites a method which provides a virtual, cellular telephone Book-of-the-Month Club. In a Book-of-the-Month Club, the subscriber receives by mail every month an offer to receive a particular book. The subscriber either rejects or accepts the offer, by mailing back the offer with a written indication as to the choice of the subscriber. In some cases, the book itself is mailed with the offer to the subscriber, and the subscriber either keeps it (indicating acceptance) or sends it back (indicating rejection). In independent Claim 24, a user signs up for a subscription service on the Internet, after which offers for digitally formatted electronic texts are sent, without any action on the user's part, to the user's cellular telephone, along with at least a portion of the digitally formatted electronic text. The user may preview a portion of the digitally formatted electronic text being offered. The user responds to the offer via the cellular telephone network, and then, if the user accepts the offer, either the remaining portion of the digitally formatted electronic text is downloaded, or a decoding message for unlocking the remaining portion of the digitally formatted electronic text is forwarded to the user.

This is unlike any of the systems described in any of the references. Furthermore, no combination of the cited references suggests an overall system as described in independent Claim 24. For example, in the virtual library of *Foledare*, subscribers create lists of material which the subscriber system holds for them, and then "loans" out to the subscribers when the subscribers want the material. In the radio subscription service of LAMBERT, a continuous stream of audio material is sent to a satellite radio of the user, either on a monthly or pay-per-listen basis. Thus, LAMBERT refers to a radio service subscription (like a subscription to a magazine or a cable TV service), and *Foledare* maintains a virtual library for its subscribers, in comparison to Claim 24 of the present application, which provides a virtual Book-of-the-Month club for a cellular telephone to receive offers for digitally formatted electronic texts.

The combination of LAMBERT, *Foladere*, *Eller*, ROTHBLATT, *Rakavy*, and AT&T neither teaches nor suggests the virtual Book-of-the-Month Club in which electronic texts are offered for download to a subscriber's cellular telephone as recited in detail in independent Claim 24. Because that combination does not teach all the limitations recited in Claim 24, and for the additional reason that no adequate motivation for combining all those references has been provided, it is respectfully requested that the rejection of Claim 24 be withdrawn.

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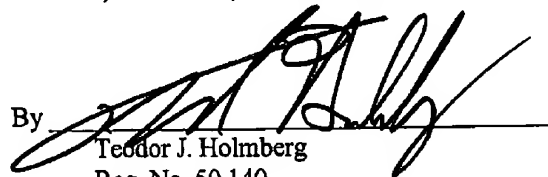
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At least for the foregoing reasons, the single pending independent claim is believed to be in condition for allowance, which is respectfully requested.

Respectfully submitted,

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Dated: June 7, 2004